REMARKS

In accordance with the foregoing, the specification and claims 1 and 13 have been amended. Claims 1-25 are pending, with claims 1 and 13 being independent. No new matter is presented in this Amendment.

Double Patenting Rejections

Claims 1-5 and 13 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-6, and 16 of copending Application No. 10/811,976. This provisional rejection is respectfully traversed.

The Examiner made a similar provisional rejection in the Office Action of February 4, 2008, which the applicants traversed with the arguments on pages 8-11 of the Amendment of May 2, 2008. In response to these arguments, the Examiner provides the following modified explanation of the rejection on pages 3 and 4 of the Office Action of August 1, 2008:

> Although the conflicting claims are not identical, they are not patentably distinct from each other because claim1-5 [sic] and 13 of the present application is [sic] anticipated by claim1, [sic] 3-6 and 16 of copending application respectively.

Also, the Examiner states as follows on page 2 of the Office Action of August 1, 2008:

> Regarding double patenting rejection, the instant application claims information storage medium for use with recording and/or reproducing apparatus having an <u>ENAV buffer</u>, medium comprising <u>ENAV buffer configuration information for use by the apparatus in allocating at least a portion of the ENAV buffer to be an updatable markup area.</u> The copending application claims recording and/or reproducing apparatus includes <u>ENAV buffer</u>; and <u>ENAV engine to allocate at least a portion of the ENAV buffer as an updatable markup area based on ENAV buffer configuration information.</u> The copending application, "ENAV engine" is more specific than the instant application "apparatus" used to allocate portion of ENAV buffer. The more specific claims anticipate the broader (*see In re Goodman*-29 USPQ2d 2010).

However, claims 1, 3-6, and 16 of copending Application No. 10/811,976 recite <u>a recording and/or reproducing apparatus</u>, while claims 1-5 and 13 of the present application recite <u>an information storage medium for use with a recording and/or reproducing apparatus,</u>

and it is not seen how the recording and/or reproducing apparatus recited in claims 1, 3-6, and 16 of copending Application No. 10/811,976 can reasonably be considered to anticipate the information storage medium for use with a recording and/or reproducing apparatus recited in claims 1-5 and 13 of the present application as alleged by the Examiner.

With respect to the Examiner's statement that "[t]he more specific claims anticipate the broader (*see In re Goodman-29 USPQ2d 2010)*," the Examiner's attention is directed to MPEP 806.04(i) on MPEP pages 800-43 and 800-44, which states as follows:

> If a generic claim is presented after the issuance of a patent claiming one or more species within the scope of the generic claim, the Office may reject the generic claim on the grounds of obviousness-type double patenting when the patent and application have at least once common inventor and/or are either (1) commonly assigned/owned or (2) non-commonly assigned/owned but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3). See MPEP § 804. Applicant may overcome such a rejection by filing a terminal disclaimer. See *In re Goodman*, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2016 (Fed. Cir. 1993); In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

Thus, Goodman stands for the proposition that earlier-patented species claims anticipate later-presented generic claims, not that "[t]he more specific claims anticipate the broader" as alleged by the Examiner. Here, it is not seen how claims 1-5 and 13 of the present application that recite an information storage medium for use with a recording and/or reproducing apparatus can reasonably be considered to be generic claims with respect to claims 1, 3-6, and 16 of copending Application No. 10/811,976 that recite a recording and/or reproducing apparatus, such that the Examiner's reliance on Goodman is improper.

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claims 1-5 and 13 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-6, and 16 of copending Application No. 10/811,976 be withdrawn.

Claim Rejections Under 35 USC 101

Rejection 1

 Claims 1-25 have been rejected under 35 USC 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

 The Examiner states as follows:

> Claim1-25 [*sic*] is [*sic*] rejected under 35 U.S.C. 101 because it [*sic*] claims a storage medium, which by [*sic*] the specification is disclosed to include carrier wave [*sic*] (see specification page19 [*sic*] paragraph 0059). This is non-statutory subject [*sic*] since the signal is not being altered in any way.

 Although the propriety of this rejection is <u>not</u> conceded, paragraph [0059] of the specification has been amended to <u>delete</u> carrier waves from the examples of a storage medium, thereby rendering this rejection <u>moot</u>.

 For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-25 under 35 USC 101 as being directed to non-statutory matter be <u>withdrawn</u>.

Rejection 2

 Claims 1-25 have been rejected under 35 USC 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

 The Examiner states as follows:

> Claim1-25 [*sic*] is [*sic*] rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite "information storage medium" which is non-statutory subject matter. The claimed "information storage medium" can be given a broad interpretation which can be anything includes [*sic*] piece [*sic*] of paper and carrier [*sic*] signal therefore [*sic*] it is non-statutory subject matter.

 Although the propriety of the rejection is <u>not</u> conceded, independent claims 1 and 13 have been amended to recite that "the information storage medium is <u>a physical information storage medium that is readable by the recording and/or reproducing apparatus</u>" to eliminate the possibility of broadly interpreting the "information storage medium" recited in claims 1 and 13 to

include a piece of paper and a carrier signal as proposed by the Examiner, thereby rendering this rejection <u>moot</u>.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-25 under 35 USC 101 as being directed to non-statutory matter be <u>withdrawn</u>.

<u>Claim Rejections Under 35 USC 102</u>

Claims 1-25 have been rejected under 35 USC 102(e) as being anticipated by Tsumagari et al. (Tsumagari) (U.S. Patent Application Publication No. 2003/0161615). This rejection is respectfully traversed.

<u>The Examiner's Explanation of the Rejection Is Incomplete</u>

The Examiner's explanation of the rejection consists of a copy of claims 1-25 into which the Examiner has inserted parenthetical expressions referring to various portions of Tsumagari. However, the Examiner has <u>not</u> explained <u>why</u> he considers these portions of Tsumagari to disclose the claimed features, such that the Examiner has <u>not</u> established a *prima facie* case of anticipation with respect to claims 1-25.

<u>Claim 1</u>

<u>Feature 1</u>

It is submitted that Tsumagari does <u>not</u> disclose "<u>ENAV buffer configuration information</u> for use by the apparatus in allocating at least a portion of the ENAV buffer in which the ENAV file is to be loaded <u>to be an updateable markup area</u>" as recited in independent claim 1.

The Examiner considers this feature of claim 1 to be disclosed in paragraph [0393] of Tsumagari, which reads as follows:

> **[0393]** ENAV engine includes ENAV Buffer, XHTML+SMIL/CSS Parser, XHTML/CSS Layout Manager, ECMAScript Interpreter & DOM manipulator, SMIL Timing Engine, ENAV Interface Handler, Element Decoders, AV Renderer, Buffer Manager, and Network Manager.

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However, although this paragraph of Tsumagari discloses an ENAV Buffer and a Buffer Manager, it is not seen where this paragraph or any other portion of Tsumagari discloses "ENAV buffer configuration information for use by the apparatus in allocating at least a portion of the ENAV buffer in which the ENAV file is to be loaded to be an updateable markup area" as recited in claim 1. Nor did the Examiner explain why he considers this paragraph of Tsumagari to disclose this feature of claim 1, such that the Examiner has not established a *prima facie* case of anticipation under 35 USC 102(e) with respect to this feature of claim 1.

The ENAV Buffer is described in paragraphs [0394]-[0396] of Tsumagari, which read as follows:

> **[0394]** # ENAV Buffer
>
> **[0395]** ENAV content on both a disc and a server is loaded to the buffer for continuous/seamless playback of DVD-Video content, and the buffer can be managed by Buffer Manager via Buffer control. ENAV Buffer consists of (or comprises) ENAV-Unit Buffer (for XHTML document, Image, Non-synchronized audio with DVD-Video and Animation), Synchronized Audio Buffer and Font Buffer. The ENAV-Unit Buffer and the Synchronized Audio Buffer consist of (or comprises) two buffers respectively. One buffer is for playback and the other buffer is for download, each role changes by turns. The two-buffer can be used as one-buffer, for instance, in case that all of ENAV elements are read to the buffer before playback of ENAV content.
>
> **[0396]** ENAV-Unit Buffer is the buffers to store ENAV-Unit, which is composed of (or may be formed of) at lest one XHTML document, Image, Non-synchronized audio and Animation.

The Buffer Manager is described in paragraphs [0420]-[0421] of Tsumagari, which read as follows:

> **[0420]** # Buffer Manager
>
> **[0421]** Buffer Manager manages ENAV content in ENAV Buffer according to Buffer control from ENAV Interface Handler. For instance, Buffer Manager loads or discards ENAV content on both a disc and a server to/from the buffer. The information for buffer management is described in XHTML document or other file as download information.

Assuming *arguendo* that the XHTML document and the other ENAV elements that are stored in the ENAV Buffer as described in paragraph [0395] of Tsumagari discussed above may arguably be considered to be "an ENAV file containing ENAV data" as recited in claim 1, it is not

seen where anything <u>whatsoever</u> in paragraph [0421] of Tsumagari discussed above or any <u>other</u> portion of Tsumagari discloses that the information for buffer management referred to in paragraph [0421] of Tsumagari is "<u>ENAV buffer configuration information</u> for use by the apparatus <u>in allocating at least a portion of the ENAV buffer</u> in which the ENAV file is to be loaded <u>to be an updateable markup area</u>" as recited in claim 1. Paragraph [0421] merely discloses that the Buffer Manager <u>loads or discards ENAV content</u>, apparently in accordance with information for buffer management that is "described in XHTML document or other file as download information."

<u>Feature 2</u>

Furthermore, it is submitted that Tsumagari does <u>not</u> disclose the feature "the <u>updateable markup</u> area <u>of the ENAV buffer</u> is an area to store at least one <u>ENAV</u> file <u>that requires updating</u>" recited in claim 1.

The Examiner considers this feature of claim 1 to be disclosed in paragraph [0432] of Tsumagari, which reads as follows:

> **[0432]**   1. DVD-Video playback engine inform status information ("DVD status") to Property Buffer in ENAV Interface Handler when status changes and keep latest status information in the buffer. Regarding how much size is necessary for the buffer, how long the status information is stored and when the status information is updated.

However, although this paragraph of Tsumagari states that the <u>status information</u> stored in the <u>Property Buffer</u> is updated, the <u>Property Buffer</u> is part of the <u>ENAV Interface Handler</u> referred to in paragraph [0393] of Tsumagari discussed above, rather than part of the <u>ENAV Buffer</u> referred to in paragraph [0393] of Tsumagari discussed above. Accordingly, it is <u>not</u> seen how this paragraph of Tsumagari can be considered to disclose the feature "the <u>updateable markup</u> area <u>of the ENAV buffer</u> is an area to store at least one <u>ENAV</u> file <u>that requires updating</u>" recited in claim 1. Nor did the Examiner explain <u>why</u> he considers this paragraph of Tsumagari to disclose this feature of claim 1, such that the Examiner has <u>not</u> established a *prima facie* case of anticipation under 35 USC 102(e) with respect to this feature of claim 1.

As described in paragraph [0412] of Tsumagari, the DVD status information referred to in paragraph [0432] of Tsumagari discussed above is stored in the <u>Property Buffer</u> in the <u>ENAV</u>

Interface Handler. The DVD status information is described as follows in paragraph [0091] of Tsumagari with reference to FIG. 1 of Tsumagari:

> In this case (simultaneously with output of the DVD event signal or an appropriate timing before or after that output timing), DVD-Video playback controller 220 can output a "DVD status signal" indicating property information (e.g., an audio language, sub-picture caption language, playback operation, playback position information, time information, the contents of disc 1, and the like set in player 100) of DVD-Video player 100 to ENAV engine 300.

It is submitted that the "property information (e.g., an audio language, sub-picture caption language, playback operation, playback position information, time information, the contents of disc 1, and the like set in player 100)" referred to in the above portion of paragraph [0091] of Tsumagari is not "at least one ENAV file that requires updating" as recited in claim 1.

As discussed above, paragraph [0395] of Tsumagari discloses that an XHTML document and other ENAV elements are stored in the ENAV Buffer. However, it is not seen where anything whatsoever in Tsumagari discloses that the XHTML document and other ENAV elements require updating, such that it is not seen where paragraph [0395] or any other portion of Tsumagari discloses the feature "the updateable markup area of the ENAV buffer is an area to store at least one ENAV file that requires updating" recited in claim 1.

Claim 3

It is submitted that Tsumagari does not disclose the following features recited in dependent claim 3:

> a loading information file having a memory element including the ENAV buffer configuration information, wherein the memory element is used by the apparatus to distinguish whether the ENAV file is one of an updateable ENAV file to be loaded in the updateable markup area and another type of ENAV file which is to be loaded in another area of the ENAV buffer other than the updateable markup area.

The Examiner considers these features of claim 3 to be disclosed in paragraph [0395] of Tsumagari, which reads as follows:

> **[0395]**   ENAV content on both a disc and a server is loaded to the buffer for continuous/seamless playback of DVD-Video

content, and the buffer can be managed by Buffer Manager via
Buffer control. ENAV Buffer consists of (or comprises) ENAV-Unit
Buffer (for XHTML document, Image, Non-synchronized audio with
DVD-Video and Animation), Synchronized Audio Buffer and Font
Buffer. The ENAV-Unit Buffer and the Synchronized Audio Buffer
consist of (or comprises) two buffers respectively. One buffer is for
playback and the other buffer is for download, each role changes
by turns. The two-buffer can be used as one-buffer, for instance,
in case that all of ENAV elements are read to the buffer before
playback of ENAV content.

However, it is not seen where this paragraph or any other portion of Tsumagari discloses
"a loading information file having a memory element including the ENAV buffer configuration
information" as recited in claim 3. Nor did the Examiner explain why he considers this paragraph
of Tsumagari to disclose this feature of claim 3, such that the Examiner has not established a
prima facie case of anticipation under 35 USC 102(e) with respect to this feature of claim 3.

Furthermore, although this paragraph of Tsumagari discloses that the XHTML document
and the other ENAV elements are stored in the ENAV Buffer, it is not seen where anything
whatsoever in this paragraph of Tsumagari or any other portion of Tsumagari discloses that any
of the XHTML document and the other ENAV elements are "an updateable ENAV file to be
loaded in the updateable markup area [of the ENAV buffer]" as recited in claim 3, or "another
type of ENAV file which is to be loaded in another area of the ENAV buffer other than the
updateable markup area [of the ENAV buffer]" as recited in claim 3. Nor did the Examiner
explain why he considers this paragraph of Tsumagari to disclose these features of claim 3, such
that the Examiner has not established a *prima facie* case of anticipation under 35 USC 102(e)
with respect to these features of claim 3.

Claim 13

It is submitted that Tsumagari does not disclose "allocation information used by the
apparatus to allocate a portion of the buffer to be reserved for an interactive type of the
interactive file prior to the interactive file being loaded" as recited in independent claim 13.

The Examiner considers this feature of claim 13 to be disclosed in paragraphs [0067]
and [0395]-[0397] of Tsumagari, which read as follows:

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[0067]   More specifically, the ENAV playback information can contain file information of the ENAV contents (information of a file to be referred to, and information of a file to be referred to instead if the file to be referred to is not present or if a player does not have a function of decoding the file if that file is present), layout information (the coordinate position of an object to be displayed on a display screen, and information indicating the depth ordering if that object overlaps another object), size information (information indicating the size of each object to be displayed), synchronization information (information used to control to play back the DVD-Video contents in connection or combination with that of the ENAV contents at a predetermined timing), and duration information (information indicating the display time range or timing range of the ENAV contents).

. . . .

[0395]   ENAV content on both a disc and a server is loaded to the buffer for continuous/seamless playback of DVD-Video content, and the buffer can be managed by Buffer Manager via Buffer control. ENAV Buffer consists of (or comprises) ENAV-Unit Buffer (for XHTML document, Image, Non-synchronized audio with DVD-Video and Animation), Synchronized Audio Buffer and Font Buffer. The ENAV-Unit Buffer and the Synchronized Audio Buffer consist of (or comprises) two buffers respectively. One buffer is for playback and the other buffer is for download, each role changes by turns. The two-buffer can be used as one-buffer, for instance, in case that all of ENAV elements are read to the buffer before playback of ENAV content.

[0396]   ENAV-Unit Buffer is the buffers to store ENAV-Unit, which is composed of (or may be formed of) at lest [*sic*] one XHTML document, Image, Non-synchronized audio and Animation.

[0397]   Before starting playback of DVD-Video synchronized with ENAV contents, at least one ENAV-Unit is preloaded from a disc or a server. When another ENAV-Unit is loaded from a disc during the playback of DVD-Video, seamless playback of DVD-Video is not guaranteed. When another ENAV-Unit is downloaded from a server during the playback of DVD-Video, seamless playback of DVD-Video is guaranteed by means of the downloading information, which includes name/location/size/content type of ENAV elements.

Thus, these paragraphs of Tsumagari disclose that ENAV-Units composed of "at le[a]st one XHTML document, Image, Non-synchronized audio and Animation" are loaded into the ENAV Buffer, apparently under control of the Buffer Manager. Assuming *arguendo* that the XHTML document may arguably be considered to be "an interactive file" as recited in claim 13, it

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is <u>not</u> seen where anything <u>whatsoever</u> in these paragraphs of Tsumagari or any <u>other</u> portion of Tsumagari discloses "allocation information used by the apparatus to allocate a portion of the buffer to be reserved for an interactive type of the interactive file prior to the interactive file being loaded" as recited in claim 13. Nor did the Examiner explain <u>why</u> he considers these paragraphs of Tsumagari to disclose this feature of claim 13, such that the Examiner has <u>not</u> established a *prima facie* case of anticipation under 35 USC 102(e) with respect to this feature of claim 13.

<u>Claim 14</u>

It is submitted that Tsumagari does <u>not</u> disclose "<u>identification information</u> which is detected by the apparatus to determine the interactive file to be read and which is used by the apparatus <u>to distinguish between</u> the <u>updateable type of the interactive file</u> which is to be buffered in the <u>allocated</u> portion and <u>another type of the interactive file</u> to be buffered in <u>another area</u> of the buffer" as recited in dependent claim 14.

The Examiner considers this feature of claim to be disclosed in paragraph [0397] of Tsumagari, which reads as follows:

> [0397]   Before starting playback of DVD-Video synchronized with ENAV contents, at least one ENAV-Unit is preloaded from a disc or a server. When another ENAV-Unit is loaded from a disc during the playback of DVD-Video, seamless playback of DVD-Video is not guaranteed. When another ENAV-Unit is downloaded from a server during the playback of DVD-Video, seamless playback of DVD-Video is guaranteed by means of the downloading information, which includes name/location/size/content type of ENAV elements.

Although this paragraph of Tsumagari discloses loading at least one ENAV-Unit into the ENAV Buffer referred to in paragraphs [0395] and [0396] of Tsumagari before starting playback of DVD-Video synchronized with ENAV contents, and loading another ENAV-Unit into the ENAV Buffer during playback of the DVD-Video, it is <u>not</u> seen where anything <u>whatsoever</u> in this paragraph of Tsumagari or any <u>other</u> portion of Tsumagari discloses "<u>identification information</u> which is detected by the apparatus to determine the interactive file to be read and which is used by the apparatus <u>to distinguish between</u> the <u>updateable type of the interactive file</u> which is to be buffered in the <u>allocated</u> portion and <u>another type of the interactive file</u> to be buffered in <u>another area</u> of the buffer" as recited in claim 14. Nor did the Examiner explain <u>why</u> he considers this

paragraph of Tsumagari to disclose this feature of claim 14, such that the Examiner has <u>not</u> established a *prima facie* case of anticipation under 35 USC 102(e) with respect to this feature of claim 14.

Conclusion—Claim Rejections Under 35 USC 102

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-25 (i.e., claims 1, 3, 13, and 14 discussed above and claims 2, 4-12, and 15-25 depending directly or indirectly from claims 1, 3, and 13) under 35 USC 102(e) as being anticipated by Tsumagari be <u>withdrawn</u>.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.
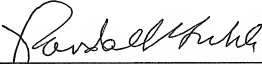
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

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